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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,757	09/20/2002	Lorenzo Torres	NMTech9	2529

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EXAMINER	
TATE, CHRISTOPHER ROBIN	
ART UNIT	PAPER NUMBER
1654	

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/042,757	TORRES, LORENZO	
	Examiner	Art Unit	
	Christopher R. Tate	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 March 2004 and 20 September 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-13,18 and 19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-13,18 and 19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The preliminary amendments filed September 20, 2002 and March 1, 2004 have been received and entered. Claims 3-13, 18, and 19 are presented for examination on the merits.

Specification

The disclosure is objected to because of the following informalities:

In the preliminary amendment of March 1, 2004, the continuation data information therein recites "This application is a divisional application of Serial Number 09/885,563, now U.S. Patent 6,465,022." However, the instant claims are drawn to the same essential invention as that claimed in US '022 and, therefore, this application is not deemed to properly constitute a "divisional application" (see, e.g., the obviousness-type double patenting rejection below). Accordingly, denoting the instant application as a "divisional application" is somewhat confusing and misleading. It is requested that the continuing data information instead recite that the instant application is a --continuation-- application of Serial Number 09/885,563.

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3-13, 18, and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,465,022. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are drawn to a method of providing an essential oil extract of capsicum containing capsaicinoid and terpene therein, via the same essential steps, including (in instant claim 5) removing stems and seeds from capsicum pods in the step of providing capsicum in powder form. Please also note that the instantly claimed invention encompasses the claimed invention of US '022.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 4, 6-13, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Etscorn et al. (US 5,674,496), in view of Negol (FR 2,721,213 - EPAB abstract).

A method of providing an essential oil extract of capsicum wherein the extract contains capsaicinoid and terpene via providing powdered capsicum, mixing the capsicum with a solvent to dissolve at least some of the capsicum, and during or after mixing, bringing the liquid solvent solution of capsicum to a temperature of $\leq 64^{\circ}C$ is claimed. Other claim limitations include the solvent being pentane or one selected from hexane, pentane, butane, propane or other non-polar solvents, and removing most of the solvent solution (to $\leq 1\%$ by volume) via heating, as well as various other conventional steps in preparing such capsicum essential oil extracts.

Etscorn et al. teach the preparation of an essential oil extract of *Capsicum* fruit whereby finely powdered habanero capsicum is mixed with a solvent at a temperature of 60-75°C for 2 minutes to 8 hours, including examples in which the powdered capsicum is subjected to solvent extraction at 75°F (which is approximately 24°F), and at 60°C for 8 hours (see, e.g., Examples 5 and 6). Etscorn et al. also disclose that capsaicin, a natural and active capsaicinoid found in *Capsicum*, can only withstand a temperature up to 68°C (see, e.g., col 5, line 38). Etscorn et al. further disclose that the solvent can be one of several including hexane (see, e.g., col 10, lines 46-60), and that the solvent may be removed by evaporation (see, e.g., col 3, line 22 - col 12, line 7, and claims). Etscorn et al. do not expressly teach certain claimed conventional working parameters including using pentane as the solvent.

Negol et al. teach preparing an extract of *Capsicum* using hexane and beneficially discloses that pentane is also a suitable hydrophobic organic solvent which can be used in place of hexane (see abstract).

It would have been obvious to one of ordinary skill in the art use of pentane and/or hexane as an extraction solvent within the method taught by Etscorn et al. based upon the beneficial teaching by Negol et al. with respect to their equivalent, interchangeable use as effective capsicum extraction solvents. In addition, the adjustment of other particular conventional working conditions (e.g., removing the solvent from the final essential oil extract product to the claimed level via heating instead of evaporation, removing harmful/interfering fungi from the capsicum fruit pod, filtering off non-dissolved material, using atmospheric pressure, etc.), is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher R. Tate
Primary Examiner
Art Unit 1654